

Appl. No. 09/929,612
Amdt. August 21, 2003
Reply to Office action of June 16, 2003

REMARKS

Claims 1, 2 and 23-41 are pending. Claims 2 and 26-28 are canceled, without prejudice. Claims 3-22 have been previously canceled. Claims 42-45 are withdrawn. New claim 46 is added. The Specification is amended to provide a new title. Claims 1, 23-25, 29, 38, and 39 are amended. Support for these claim amendments can be found, e.g., in the originally filed claims. In particular, support for the amendment to claim 24, can be found, e.g., on page 18, lines 16-31. Support for new claim 46 is found, e.g., in the Sequence Listing, and on page 13, of the specification.

Applicants note the Examiner comments on page 6, of the Office Action, that the nucleic acids of SEQ ID NO: 5 and 7, and the nucleic acids encoding the polypeptide of SEQ ID NO:8 are considered allowable subject matter. Applicants note that the nucleic acids encoding SEQ ID NO: 6 should therefore also be allowable. The Examiner further notes that claims 25-41 are free from prior art.

Applicants believe that no new matter is added by the foregoing amendments

I. Objections to the Title

The Examiner objected to the title as not being descriptive of the present invention. The new title is amended, as suggested by the Examiner. Withdrawal of this objection is respectfully requested.

II. Rejection of Claims 1, 23, 24, 26-28, and 39 under 35 U.S.C. 112, Second Paragraph

The Examiner rejected claims 1, 23, 24, 26-28, and 39 under 35 U.S.C. 112, second paragraph, for the reasons set forth below.

Claims 1 and 23 were rejected under this section for lack of sequence identifiers for the CTLA protein recited. As amended, claim 1 recites SEQ ID NO: 6 and 8, and is therefore clear and definite. Amended claim 23, which depends from claim 1, is thus also clear and definite. Claim 1 was further rejected as containing non-elected subject matter. As noted above, amended claim 1 recites the elected sequences of SEQ ID NO: 6 and 8. Claim 23 was also rejected for the recitation of "such as". As amended, claim 23 no longer recites "such as".

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Claim 24 was rejected for not providing a definition for "stringent conditions". As amended, claim 24 recites stringent conditions of "... 65° C and 150mM salt ...". Therefore, amended claim 24 is clear and definite.

Claims 26 and 27 were rejected as containing non-elected subject matter. Claim 26 and 27, as noted above are canceled.

Claim 28 was rejected for improper antecedent basis for "the coding sequence". As noted above, claim 28 is canceled.

Claim 39 was rejected for the parenthetical recitation of "autonomously". As amended, claim 39 no longer recites autonomously in parenthesis.

In view of the foregoing, the rejection of claims 1, 23, 24, 26-28, and 39 under 35 U.S.C. 112, second paragraph, is overcome. Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 24 and 26-28 under 35 U.S.C. 101.

The Examiner rejected Claims 24 and 26-28 under 35 U.S.C. 101, on the basis that the claimed invention is directed to a non-statutory subject matter. Claims 26-28 are canceled and are therefore moot as to this rejection. Claim 24, as amended, recites "[a]n isolated nucleic acid ...".

In view of the foregoing, Applicants submit that the rejection of claims 24 and 26-28 under 35 U.S.C. 101, is overcome. Withdrawal of this rejection is respectfully requested.

IV. Rejections of Claims 1, 2 and 23-41 under 35 U.S.C. 112, First Paragraph.

The Examiner rejected Claims 1, 2 and 23-41 under 35 U.S.C. 112, first paragraph. Claims 2 and 26-28 are canceled and the rejection is therefore moot as to these claims. The bases for the rejection of remaining pending claims 1, 23-25, and 29-41 are the recitation of "fragments" and the lack of sequence identifiers. As amended, claim 1 recites SEQ ID NO: 6 and 8, and does not recite fragments. Thus, amended claim 1 is fully described in the specification, as are claims 23-25 and 29-41, which depend directly or indirectly from amended claim 1.

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In view of the forgoing, Applicants submit that the rejection of claims 1, 2, and 23-41 under 35 U.S.C. 112, first paragraph, is overcome. Withdrawal of this rejection is respectfully requested.

V. Rejections of Claims 1, 2, 23, and 24 under 35 U.S.C. 102(b).

The Examiner rejected Claims 1, 2, 23, and 24 under 35 U.S.C. 102(b) as being anticipated by the 1992 Gibco BRL catalog. Claim 2 is canceled and is therefore moot as to this rejection. The basis for this rejection is the recitation of "fragments". As amended, pending claims 1, 23, and 24 no longer recite fragments. Thus the cited reference fails to anticipate the claimed invention.

In view of the forgoing, Applicants believe that the rejection of claims 1, 2, 23, and 24 under 35 U.S.C. 102(b), is overcome. Withdrawal of this rejection is respectfully requested.

Conclusion

Applicants' current response is believed to be a complete reply to all the outstanding issues of the latest Office action. Further, the present response is a bona fide effort to place the application in condition for allowance or in better form for appeal. Accordingly, Applicants respectfully request reconsideration and passage of the amended claims to allowance at the earliest possible convenience.

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Applicants believe that no additional fees are due with this communication. Should this not be the case, the Commissioner is hereby authorized to debit any charges or refund any overpayments to DNAX Deposit Account No. 04-1239.

If the Examiner believes that a telephonic conference would aid the prosecution of this case in any way, please call the undersigned.

Respectfully submitted,

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